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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,668	06/01/2001	Darrel D. Cherry	10008156-1	2901

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HEWLETT-PACKARD COMPANY
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EXAMINER

YOUNG, JOHN L

ART UNIT PAPER NUMBER

3622

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/872,668

Applicant(s)

CHERRY ET AL.

Examiner

John L. Young

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/18/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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FIRST ACTION REJECTION

(Paper# 10/18/2004)

DRAWINGS

1. This application has been filed with drawings that are considered informal; said drawings are acceptable for examination purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

CLAIM REJECTIONS — 35 U.S.C. §103(a)

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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2. Claims 1-14 are rejected under 35 U.S.C. §103(a) as being obvious over Castle US 2002/0077891 (06/20/2002) [US f/d: 12/15/2000] (herein referred to as "Castle").

As per independent claim 1, Castle (the ABSTRACT; FIG. 1; ¶¶[0001]; [0004]; [0005]; [0006]; [0009]; [0010]; [0011]; [0012]; [0013]; [0014]; [0015]; [0016]; [0017]; [0018]; [0019]; [0022]; [0023]; [0024]; [0025]; [0026]; [0027]; [0028]; [0029]; and [0031]; and whole document) shows: "A method for targeting advertisements into media on demand selected from a media selection interface, comprising: obtaining a set of user information; obtaining a media request . . . determining a set of advertisement space information from said electronic copy of said media request for at least one advertisement space in said media request; communicating said set of advertisement space information to at least one advertising provider; receiving at least one bid from said at least one advertising provider; comparing said received bids for said at least one advertisement space; choosing a winning bid for said at least one advertisement space; querying said at least one advertising provider for an electronic copy of an advertisement for said advertisement space associated with said winning bid; receiving said electronic copy of said advertisement. . . ."

Castle lacks explicit recital of "receiving an electronic copy of said media request . . . and combining said electronic copy of said advertisement with said media request. . . ."; however,

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Castle (§ [0006]; and FIG. 1, el. 102, el. 104, el. 106, & el. 108) discloses:

“obtaining from at least one potential advertiser, an offer . . . to place an advertisement . . . in the publication.” The examiner interprets this disclosure as showing “receiving an electronic copy of said media request . . .”; and the examiner interprets Castle (§ [0012]; and FIG. 1, el. 102, el. 104, el. 106, & el. 108)) as implicitly showing “combining said electronic copy of said advertisement with said media request. . . .”

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Castle (the ABSTRACT; FIG. 1; ¶¶[0001]; [0004]; [0005]; [0006]; [0009]; [0010]; [0011]; [0012]; [0013]; [0014]; [0015]; [0016]; [0017]; [0018]; [0019]; [0022]; [0023]; [0024]; [0025]; [0026]; [0027]; [0028]; [0029]; and [0031]; and whole document) implicitly shows “receiving an electronic copy of said media request . . . and combining said electronic copy of said advertisement with said media request. . . .”, and it would have been obvious to modify and interpret the disclosure of Castle cited above as implicitly showing “receiving an electronic copy of said media request . . . and combining said electronic copy of said advertisement with said media request. . . .”, because modification and interpretation of the cited disclosure of Castle would have provided *“a method and apparatus for automatically auctioning advertising space at market rates to prospective advertisers in an on-line publication. . . .”* (see Castle (§ [0006])), based on the motivation to modify Castle so as to *“[generate] revenue in on-line publishing.”* (See Castle (§ [0005])).

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As per dependent claim 2, Castle shows the method of claim 1.

Castle (the ABSTRACT; ¶¶[0001]) discloses “*subscribers. . .*” Castle (the ABSTRACT; ¶¶[0001]; [00010]; [0014]; [0015]; [0016]; [0020]; [0024]; [0026]; and [0031]) implicitly shows the “log-in” and profile elements of claim 2 (The examiner interprets the “subscribers. . .” disclosure combined with the profile and demographic disclosures as showing log-in elements); however,

Castle lacks a verbatim recital of the “log-in” elements of claim 2; it would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Castle (the ABSTRACT; ¶¶[0001]; [00010]; [0014]; [0015]; [0016]; [0020]; [0024]; [0026]; and [0031]; and whole document) implicitly shows the “log-in” and profile elements of claim 2; and it would have been obvious to modify and interpret the disclosure of Castle cited above as showing the “log-in” and profile elements of claim 2, because modification and interpretation of the cited disclosure of Castle would have provided “*a method and apparatus for automatically auctioning advertising space at market rates to prospective advertisers in an on-line publication. . .*” (see Castle (¶ [0006]), based on the motivation to modify Castle so as to “[*generate*] revenue in on-line publishing.” (See Castle (¶ [0005])).

Dependent claim 3 is rejected for at least the same reasons as dependent claim 2.

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As per dependent claim 4, Castle shows the method of claim 2.

Castle (FIG. 1; the ABSTRACT; ¶¶[0001]; [00010]; [0014]; [0015]; [0016]; [0020]; [0024]; [0026]; and [0031]) implicitly shows the “log-in”, “profile” and “bidding” elements of claim 4; however,

Castle lacks a verbatim recital of the “log-in”, “profile” and “bidding” elements of claim 4; it would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Castle (FIG. 1; the ABSTRACT; ¶¶[0001]; [00010]; [0014]; [0015]; [0016]; [0020]; [0024]; [0026]; and [0031]; and whole document) implicitly shows the “log-in”, “profile” and “bidding” elements of claim 4; and it would have been obvious to modify and interpret the disclosure of Castle cited above as showing the “log-in”, “profile” and “bidding” elements of claim 4, because modification and interpretation of the cited disclosure of Castle would have provided “*a method and apparatus for automatically auctioning advertising space at market rates to prospective advertisers in an on-line publication. . . .*” (see Castle (¶ [0006]), based on the motivation to modify Castle so as to “[*generate*] revenue in on-line publishing.” (See Castle (¶ [0005])).

As per dependent claim 5, Castle shows the method of claim 1.

Castle (the ABSTRACT; FIG. 1; ¶¶[0001]; [0004]; [0005]; [0006]; [0009]; [0010]; [0011]; [0012]; [0013]; [0014]; [0015]; [0016]; [0017]; [0018]; [0019]; [0022]; [0023]; [0024]; [0025]; [0026]; [0027]; [0028]; [0029]; and [0031]; and whole

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document) implicitly shows locating an advertisement space in said electronic copy of said media request; [and] assigning said advertisement space a unique identification number. . . .” elements and limitations of claim 5.

Castle lacks explicit recital of the “determining the dimensions of said advertisement space; [and] determining the location of said advertisement space in said media request. . . .”

“Official Notice” is taken that both the concepts and the advantages of the “determining the dimensions of said advertisement space; [and] determining the location of said advertisement space in said media request. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention because; for example, it would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Castle (the ABSTRACT; FIG. 1; ¶¶[0001]; [0004]; [0005]; [0006]; [0009]; [0010]; [0011]; [0012]; [0013]; [0014]; [0015]; [0016]; [0017]; [0018]; [0019]; [0022]; [0023]; [0024]; [0025]; [0026]; [0027]; [0028]; [0029]; and [0031]; and whole document) implicitly shows the “determining the dimensions of said advertisement space; [and] determining the location of said advertisement space in said media request. . . .”, and it would have been obvious to modify and interpret the disclosure of Castle cited above as implicitly showing the “determining the dimensions of said advertisement space; [and] determining the location of said advertisement space in said media request. . . .” because modification and interpretation of the cited disclosure of Castle would have provided “*a method and apparatus for automatically auctioning advertising space at market rates to*

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prospective advertisers in an on-line publication. . . ." (see Castle (§ [0006]), based on the motivation to modify Castle so as to "[generate] revenue in on-line publishing." (See Castle (§ [0005])).

Dependent claim 6 is rejected for at least the same reasons as presented in the rejection of independent claim 1.

As per dependent claim 7, Castle shows the method of claim 6.

Castle (the ABSTRACT; FIG. 1; ¶¶[0001]; [0004]; [0005]; [0006]; [0009]; [0010]; [0011]; [0012]; [0013]; [0014]; [0015]; [0016]; [0017]; [0018]; [0019]; [0022]; [0023]; [0024]; [0025]; [0026]; [0027]; [0028]; [0029]; and [0031]; and whole document) implicitly shows the "data file" "advertisement space" and "electronic copy" elements of claim 7.

Castle lacks explicit recital of the "dimensions" and "unique identification number" elements and limitations of claim 7.

"Official Notice" is taken that both the concepts and the advantages of the "dimensions" and "unique identification number" elements and limitations of claim 7 were well known and expected in the art by one of ordinary skill at the time of the invention because; for example, it would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Castle (the ABSTRACT; FIG. 1; ¶¶[0001]; [0004]; [0005]; [0006]; [0009]; [0010]; [0011]; [0012]; [0013]; [0014]; [0015];

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[0016]; [0017]; [0018]; [0019]; [0022]; [0023]; [0024]; [0025]; [0026]; [0027]; [0028]; [0029]; and [0031]; and whole document) implicitly shows the “dimensions” and “unique identification number” elements and limitations of claim 7, and it would have been obvious to modify and interpret the disclosure of Castle cited above as implicitly showing the “dimensions” and “unique identification number” elements and limitations of claim 7, because modification and interpretation of the cited disclosure of Castle would have provided “*a method and apparatus for automatically auctioning advertising space at market rates to prospective advertisers in an on-line publication. . . .*” (see Castle (¶ [0006]), based on the motivation to modify Castle so as to “[*generate*] revenue in on-line publishing.” (See Castle (¶ [0005])).

Dependent claim 8 is rejected for at least the same reasons as presented in the rejection of independent claim 1.

Independent claim 9 is rejected for substantially the same reasons as independent claim 1.

As per claim 10, Castle (the ABSTRACT; FIG. 1; ¶¶[0001]; [0004]; [0005]; [0006]; [0009]; [0010]; [0011]; [0012]; [0013]; [0014]; [0015]; [0016]; [0017]; [0018]; [0019]; [0022]; [0023]; [0024]; [0025]; [0026]; [0027]; [0028]; [0029]; and [0031]; and whole document) implicitly shows bidding for advertisement space in a media on demand

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system . . . receiving a set of advertisement space information, said set of advertisements space information . . . location for each available advertisement space in a media request; receiving a user profile; assigning a value to each of said available advertisement spaces based upon said set of advertisement space information and said user profile; and communicating a bid to a service provider for each available advertisement space desired.

Castle lacks explicit recital of the “information including a unique identification number for each available advertisement space, a set of dimensions for each available advertisement space. . . .”

“Official Notice” is taken that both the concepts and the advantages of the “information including a unique identification number for each available advertisement space, a set of dimensions for each available advertisement space. . . .” were well known and expected in the art by one of ordinary skill at the time of the invention because; for example, it would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Castle (the ABSTRACT; FIG. 1; ¶¶[0001]; [0004]; [0005]; [0006]; [0009]; [0010]; [0011]; [0012]; [0013]; [0014]; [0015]; [0016]; [0017]; [0018]; [0019]; [0022]; [0023]; [0024]; [0025]; [0026]; [0027]; [0028]; [0029]; and [0031]; and whole document) implicitly shows the “information including a unique identification number for each available advertisement space, a set of dimensions for each available advertisement space. . . .” , and it would have been obvious to modify and interpret the disclosure of Castle cited above as implicitly showing the “information including a unique identification number for each available advertisement space, a set of

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dimensions for each available advertisement space. . . .” because modification and interpretation of the cited disclosure of Castle would have provided “*a method and apparatus for automatically auctioning advertising space at market rates to prospective advertisers in an on-line publication. . . .*” (see Castle (¶ [0006]), based on the motivation to modify Castle so as to “[generate] revenue in on-line publishing.” (See Castle (¶ [0005])).

As per dependent claim 11, Castle shows the method of claim 10. of Castle (the ABSTRACT; FIG. 1; ¶¶[0001]; [0004]; [0005]; [0006]; [0009]; [0010]; [0011]; [0012]; [0013]; [0014]; [0015]; [0016]; [0017]; [0018]; [0019]; [0022]; [0023]; [0024]; [0025]; [0026]; [0027]; [0028]; [0029]; and [0031]; and whole document) implicitly shows the elements and limitations of claim 11; however,

Castle lacks a verbatim recital of the elements and limitations of claim 11.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Castle (FIG. 1; the ABSTRACT; ¶¶[0001]; [00010]; [0014]; [0015]; [0016]; [0020]; [0024]; [0026]; and [0031]; and whole document) implicitly shows the elements and limitations of claim 11, and it would have been obvious to modify and interpret the disclosure of Castle cited above as showing the elements and limitations of claim 11, because modification and interpretation of the cited disclosure of Castle would have provided “*a method and apparatus for automatically auctioning advertising space at market rates to prospective advertisers in an on-line*

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publication. . . .” (see Castle (§ [0006]), based on the motivation to modify Castle so as to “[generate] revenue in on-line publishing.” (See Castle (§ [0005])).

Dependent claim 12 is rejected for at least the same reasons as the rejection of the “dimensions” and “advertisement space” elements and limitations of claim 10.

Independent apparatus claim 13 is rejected for substantially the same reasons as independent method claim 1.

As per claim 14, Castle shows the method of claim 13.

Castle (the ABSTRACT; FIG. 1; ¶¶[0001]; [0004]; [0005]; [0006]; [0009]; [0010]; [0011]; [0012]; [0013]; [0014]; [0015]; [0016]; [0017]; [0018]; [0019]; [0022]; [0023]; [0024]; [0025]; [0026]; [0027]; [0028]; [0029]; and [0031]; and whole document) implicitly shows the “preferred user data corresponding to said at least one advertisement stored in said memory. . . .” elements and limitations of claim 14.

Castle lacks explicit recital of the “dimensions” elements and limitations of claim 14.

“Official Notice” is taken that both the concepts and the advantages of the “dimensions” elements and limitations of claim 14 were well known and expected in the art by one of ordinary skill at the time of the invention because; for example, it would have been obvious to a person of ordinary skill in the art at the time of the invention that

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the disclosure of Castle (the ABSTRACT; FIG. 1; ¶¶ [0001]; [0004]; [0005]; [0006]; [0009]; [0010]; [0011]; [0012]; [0013]; [0014]; [0015]; [0016]; [0017]; [0018]; [0019]; [0022]; [0023]; [0024]; [0025]; [0026]; [0027]; [0028]; [0029]; and [0031]; and whole document) implicitly shows the “dimensions” elements and limitations of claim 14, and it would have been obvious to modify and interpret the disclosure of Castle cited above as implicitly showing the “dimensions” elements and limitations of claim 14, because modification and interpretation of the cited disclosure of Castle would have provided “*a method and apparatus for automatically auctioning advertising space at market rates to prospective advertisers in an on-line publication. . . .*” (see Castle (¶ [0006]), based on the motivation to modify Castle so as to “[*generate*] revenue in on-line publishing.” (See Castle (¶ [0005])).

CONCLUSION

3. Any response to this action should be mailed to:

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(703)305-7687 (for formal communications EXPEDITED PROCEDURE) or

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Hand delivered responses may be brought to:

Serial Number: 09/872,668

(Cherry et al.)

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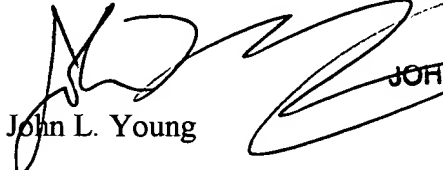
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.


John L. Young
Primary Patent Examiner


JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

October 18, 2004